

Appl. No. : 09/873,339  
Filed : June 5, 2001

### REMARKS

The June 26, 2006 Office Action was based upon pending Claims 1-26. This Response After Final does not amend any of the pending claims. Rather this Response addresses the legal error associated with the reliance by the Examiner on certain portions of the text in the continuation-in-part U.S. Publication No. 2002/0073046.

#### **Claim Rejections**

The Office Action rejected Claims 1-26 under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2002/0073046 to David.

#### **Rejection of Claims 1-26 under 35 U.S.C. §102(e)**

U.S. Publication No. 2002/0073046 was filed in June 6, 2001 and is a **continuation-in-part** of U.S. Patent Application 09/500,601 filed on February 8, 2000.

For clarity, Applicant will refer to U.S. Patent Application 09/500,601 as the "'601 Parent Application." Because U.S. Publication No. 2002/0073046 is a continuation-in-part of the '601 Parent Application, Applicant will refer to U.S. Publication No. 2002/0073046 as the "David CIP Publication."

In addition, the David CIP Publication also claims priority two earlier filed provisional applications (60/167,352 and 60/146,628). The Examiner appears to be relying on the claim of priority in David CIP Publication to the '601 Parent Application as a basis for qualifying the David CIP Publication as prior art under 35 USC 102(e).

In order to reject the currently pending claims under § 102(e), the Examiner should only rely on the portion of the text in the '601 Parent Application that was carried forward to the David CIP Publication. Accordingly, Applicant respectfully requests the Examiner identify the relevant portions of the disclosure of the David CIP Publication that were carried forward from the '601 Parent Application.

For example, the Examiner relies on [0075], [0076], [0133], [0139] and [0165] of the David CIP Publication as teaching the step of associating the interaction identification string with the machine fingerprint. It appears to the Applicant, however,

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that the text relied upon by the Examiner is new matter that is not entitled to the filing date of the '610 Parent Application.

Thus, Applicant respectfully requests that the Examiner provide a basis for why the Examiner believes that cited text from the David CIP Publication was carried forward from the '610 Parent Application.

**The Examiner has not shown in the '601 Parent Application where the claimed invention is disclosed and so the rejection is improper.**

The June 6, 2001 filing date of the David CIP Publication is later than the June 5, 2001 priority date of the present application. Thus, the David CIP Publication is not itself prior art, i.e. it does not qualify as prior art under 35 U.S.C. § 102(e). The relevant portion of 35 U.S.C. § 102(e) provides that:

A person shall be entitled to a patent unless: (e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, ... .

The Office Action states that applicant has argued that the cited portions of David (pars. 0075, 0076, 0133, 0139, and 0165) fail to suffice as prior art because of their lack of support in the '610 Parent Application. In addressing this issue, the Office Action responded as follows:

"The Examiner has reviewed the parent US application, 09/600,601, and finds support in its disclosure for the relied upon paragraphs of David used to reject the claimed limitations. Therefore in accordance with 35 USC 112 first paragraph, the cited disclosure of David does receive the priority date (February 8, 2000) of the parent US application and consequently qualifies as prior art. Applicant's arguments are therefore non-persuasive and the rejection under David is maintained. For further information, Applicant is directed to MPEP chapter 103 item (v), for further instruction in this matter." (June 26, 2006 Office Action at Page 3.)

Applicant respectfully insists that such a response is insufficient as the cited portions appear to be new matter that were not disclosed in the '601 Parent Application. For a rejection based on 35 U.S.C. § 102(e), per the MPEP Section 706.02(f)(1), MPEP Section 2136.03 part IV, and as informed by the Court of Customs and Patent

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Appeals (in *In re Wertheim*, below), the Examiner must show where in the '601 Parent Application the Examiner finds disclosure that is 1) sufficient to reject the claims and 2) that is "carried forward" to the David CIP Publication.

Applicant notes that the MPEP at 706.02(f)(1) explains:

The 35 USC 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective US filing date, taking into consideration any proper benefit claims to prior US applications under 35 USC 119(e) or 120 ***if the prior application(s) properly supports the subject matter used to make the rejection.***" [Emphasis added.]

Thus, assuming, *arguendo*, that the David CIP Publication can claim of priority to the '601 Parent Application, the Examiner must show the text of the '601 Parent Application that "*properly supports the subject matter used to make the rejection.*"

MPEP Section 2136.03 part IV specifically addresses how to address the priority dates of continuation-in-part references. In particular, the MPEP states:

"In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the **>U.S. patent reference<** must **\* have a right of priority to the earlier date under 35 U.S.C. 120 or 365(c) and >the parent application must<** support the invention claimed as required by 35 U.S.C. 112, first paragraph."

Applicant notices that the MPEP is not express as to the burden on the Examiner in this respect, but in *In re Wertheim*, the Court of Customs and Patent Appeals explained:

"If, for example, the PTO wishes to utilize against an applicant a part of [a] patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains Sections 120/112 support for the invention claimed in the referenced patent. For if a patent *could not* theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art,' ... ." [First emphasis added; second emphasis in original.] *In re Wertheim*, 209 USPQ 554, 564 (CCPA, 1981).

Thus, it is a clear requirement on the Office to make a showing that a priority application contains the subject matter found in the reference application and relied on by the Examiner.

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Further, the Office must actually demonstrate that a patent could have issued for the invention claimed in the referenced patent based only on what was included in the earlier-filed application, i.e. that "the earlier-filed application contains section 120/112 support."

The Court in *In re Wertheim* provided further clarification. In the matter at bar there, the PTO had relied on a patent having a filing date of February 10, 1969, referred to as *Pfluger IV*, based on its having a claim of priority as a continuation-in-part of an application in a series of applications, ultimately to an application (*Pfluger I*) filed on March 24, 1961, which date preceded the filing date of the application being examined. The Court explained:

"The only date the *Pfluger* patent has under Section 102(e) is February 10, 1969, the filing date of *Pfluger IV*, the application on which the patent issued. Any earlier US filing date for the patent necessarily depends on further compliance with Sections 120 and 112. The Board [which insisted on using the filing date of the very first application in the series of applications] appears to have assumed the existence of the very point at issue here -- whether the patent reference is entitled to a March 24, 1961 filing date. See, *Id.* at 565.

Thus, the Office cannot simply assume that the prior application properly supports the subject matter used to make a rejection, but must in fact provide a showing of same."

The Court in *In re Wertheim* also reminded us that disclosure must not only be sufficient in the earlier-filed application, but must be "carried over" to the later-filed application (that then issues as a patent). The Court explained that it had earlier (in *In re Lund*, 153 USPQ 625 (CCPA, 1967)) stated it to be:

"While some of the referenced patent disclosure can be traced to *Pfluger I*, such portions of the original disclosure cannot be found 'carried over' for the purpose of awarding filing dates, unless that disclosure constituted a full, clear, concise and exact description in accordance with Section 112, first paragraph, of the invention claimed in the referenced patent, else the application would not have matured into a patent ... to be 'prior art' ... ." See, *Id.* at 565 (Emphasis Added).

Furthermore, the Court stated:

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"...well settled that where a patent purports on its face to be a 'continuation-in-part' of a prior application, the continuation-in-part application is entitled to the filing date of the parent applicant as to all subject matter carried over into it from the parent application, whether for purposes of obtaining a patent or subsequently utilizing the patent disclosure as evidence to defeat another's right to a patent." *Id.* at 561.

The Court then explained that:

"In deciding what had been 'carried over,' the [*In re Lund*] court held that merely designating an application as a continuation-in-part was not sufficient to incorporate by reference the disclosure of the abandoned application into the patent disclosure, 'as if fully set out therein.' The [*In re Lund*] court concluded that:

It seems to us that the sine qua non of §102(e) and the Milburn case [where a CIP omitted disclosure from a parent application and it was the omitted disclosure that was relied on by the Examiner] is that, consistent with the gain to the public which the patent laws mean to secure, a *patent must issue* which contains, explicitly or implicitly, the description of an invention which is to be relied on to defeat a latter inventor's patent rights." [Emphasis in the original.] *Id.* at 561.

The law is thus clear that 1) an Examiner must demonstrate that the earlier-filed application, the '601 Parent Application, contains the disclosure relied on, and 2) that the disclosure was carried forward in the David CIP Publication. The Examiner here has not done this.

Accordingly, applicant respectfully requests that the rejections under 35 U.S.C. §102(e) be reconsidered and withdrawn.

### **Correspondence**

Applicant respectfully notes that Applicant filed a Revocation and Power of Attorney on May 27, 2004. Unfortunately, the Final Office Action was mailed to Applicant's previous counsel. Therefore, Applicant respectfully requests that future correspondence be directed to Knobbe, Martens, Olson and Bear.

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### Conclusion

Thus, the rejection must be withdrawn at least for failure of the Office to demonstrate where in the '601 Parent Application the relied on disclosure is to be found.

Although amendments and cancellations have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments and cancellations are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Furthermore, any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

In view of the forgoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Examiner is cordially invited to contact the undersigned such that any remaining issues may be promptly resolved. Also, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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